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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,187	06/13/2001	Kurt Ryl	2360-0473PUS1	3997
2292 7590 03/06/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER MCDONOUGH, JAMES E				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
03/06/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

09/879,187

Applicant(s)

RYF ET AL.

Examiner

JAMES E. MCDONOUGH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-33 and 35-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-33 and 35-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Original Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-29, 31-41, 44, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Coffee et al. (3,108,916).

Coffee discloses the basic method of coating a nitrocellulose grain with an ester deterrent or energetic plasticizer or both (col. 2, lines 65-72 and col. 31-10). The deterrent and plasticizer are mixed in solution and coated onto the nitrocellulose grain, the grain can also include additives such as cyclotrimethylenetrinitramine (col. 3, lines 50-60). The nitrocellulose grain may be any size or shape (col. 2, lines 50-65). The nitrogen content and diffusion depth are inherent properties of the product as described. Where a product appears to be the same or only slightly different, the properties recited appear to be inherent, regardless of the method of preparation. The Office does not have testing facilities to determine such. The burden falls on applicant to show that the prior art products do not necessarily or inherently possess the claimed

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properties. In re Thorpe, 777 F.2d 695, 697; 227 USPQ 964,966; In re Fitzgerald, 619 F.2d 67, 70; 205 USPQ.594, 596; In re Best, 562 F.2d 1252, 1255; 195 USPQ 430, 433-434; In re Brown, 459 F.2d 531; 173 USPQ 685.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 30, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coffee et al. (3,108,916) as applied to claims 19-41, 44, and 45 above.

Regarding claim 42

Although, the reference is silent as to the use of a reactor tank, it is conventional to use a reactor tank to prepare compositions and applicants have

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shown no criticality for the use of a reactor tank versus another container. Further examiner would like to note that any tank/container in which a reaction is taking place is by default a reactor tank.

Regarding claims 30 and 43

Although, the reference is silent as to the pressure while draining and the use of warm air to dry the composition the reference teaches that any conventional method for drying can be used (column 2, lines 46-48).

Response to Arguments

Applicants argue against the 112 rejection over claim 34. This argument is found persuasive therefore, it has been withdrawn.

Applicants argue against the 112 rejection over claims 19-37. IF applicants are admitting that any polymer will serve to desensitize the composition, then the argument is persuasive and the rejection is withdrawn.

Applicants argue that the reference of Coffee disclose the diester do not penetrate into the grain. While it is true that the reference does state that the emulsion only form a molecular coating, it appears that the reference and the instant application are using identical grains and identical emulsion/solutions, and it appears that the reference of Coffee is most likely incorrect in that the coating does not penetrate the grains as one would expect that if the coating penetrates

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in the instant invention that it would also penetrate in the reference absent any evidence to the contrary.

Applicants argue that the reference uses additional steps/ingredients that the instant invention. This is not persuasive because the instant invention uses comprising language.

Applicants argue that their composition is further different by the fact that they use the plasticizer and desensitizer in solution. This is not persuasive as the reference also teaches using these in a solution/emulsion (column 2, lines 27-48).

Applicants argue that the emulsion diffuse to a depth of 100-500 microns into the surface. This is a property of the composition and since properties of a compositor are inseparable from the composition itself, one skilled in the art would expect the same to happen for the reference composition absent any evidence to the contrary. With regards to the higher to the higher density and the higher energy content, this is expected as to fill an empty void with material will increase the density of the material and the more material in a given volume the more energy that can be derived from that volume.

Applicants argue that the requirements for a 102 have not been met because the energetic plasticizer and the polymeric desensitizer are in the form

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of an emulsion. This is not persuasive as the reference clearly teaches having these in the form of an emulsion (see above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES E. MCDONOUGH whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEM 2/24/2008

/Jerry A Lorengo/

Supervisory Patent Examiner, Art Unit 1793

Application Number

Application/Control No.

09/879,187

Examiner

JAMES E. MCDONOUGH

Applicant(s)/Patent under
Reexamination

RYF ET AL.

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